

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed September 21, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 103(a)**

#### **A. Rejection of Claims 1-2, 6-7, 9-10, 15-17, 21, 23-26, 28-30, and 32-33**

Claims 1-2, 6-7, 9-10, 15-17, 21, 23-26, 28-30, and 32-33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolff (U.S. Pat. No. 6,738,841). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations. Applicant discusses the Wolff reference and Applicant's claims in the following.

**A. The Wolff Reference**

Wolff discloses a method and apparatus for processing document requests at a printer server. Wolff, Patent Title. As is described by Wolff, the Wolff system can be used to retrieve and print remote documents. In such a process, a PDA 930 accesses a server 920 via a wireless connection. Wolff, column 8, lines 48-49. The PDA then receives a quote document from the server. Wolff, column 8, lines 53-55. Specifically, the quote document is downloaded to a browser provided on the PDA. Wolff, column 8, lines 35-36.

If, after reviewing the quote document, the PDA user wishes to print out a contract based on the quote, the user requests via the PDA that the contract be retrieved and printed by a printer with which the PDA shares a wireless connection. Wolff, column 8, line 66 to column 9, line 14.

Significantly, Wolff only discusses printing of remote document identified by browsing a network. Wolff says nothing about a mailbox or other repository in which the user stores documents for printing or synchronizing a list of such documents on an appliance, such as a PDA, through communications with a remote computer.

**B. Applicant's Claims**

**1. Claims 1-2, 6-7, 9-10, 26, and 28-29**

Independent claim 1 provides as follows (emphasis added):

1. A method performed on an information appliance for printing a document stored on a remote computer, the method comprising:

providing a connection between an information appliance and a remote computer, *wherein the remote computer stores one or more documents in a user mailbox;*

*transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer;*

*receiving synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing;*

*updating the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer;*

*displaying the updated list of user mailbox documents to the user on a display of the information appliance;*

receiving a selection of one or more documents from the displayed list of user mailbox documents;

receiving a command to print the one or more selected documents; and

responsive to receiving the command to print, transmitting a print request to a nearby printer that instructs the printer to retrieve the one or more selected documents from the user mailbox and print the one or more selected documents.

As a first matter regarding claim 1, Wolff does not teach or suggest a remote computer that “stores one or more documents in a user mailbox”. Instead, as is noted above, Wolff’s system permits a user to print a remote document that the user comes across while browsing a network, such as the Internet. Wolff does not contemplate a user mailbox or other repository in which a user may store documents for later remote printing.

Wolff further does not teach or suggest “transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer”, “receiving synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing”, or “updating the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer”. The reason for this is simple: Wolff does not contemplate using his system as a means for printing the user’s documents that are stored in a remote repository. Therefore, there is just no reason in Wolff’s system to perform the synchronization described in the above three limitations.

Given that no “list” of documents is provided to the network appliance or synchronized with the remote computer in Wolff’s system, it logically follows that Wolff does not teach or suggest “displaying the updated list of user mailbox documents to the user on a display of the information appliance”.

At least in view of the above, Applicant respectfully submits that claim 1 and its dependents are allowable over Wolff.

With specific regard to dependent claim 7, Applicant notes that Wolff further does not teach a “print request” sent from an information appliance to a printer that

“comprises user identification information”. This is understandable given that, as is noted above, Wolff does not teach or suggest a system for printing documents stored in the user’s remote mailbox or other repository.

## **2. Claims 15-17, 21, 23-25, 30, and 32-33**

Independent claim 15 provides as follows (emphasis added):

15. A computer-readable storage medium having stored thereon computer instructions that, when executed by an information appliance, cause the information appliance to:

provide a connection between an information appliance and a remote computer, *wherein the remote computer stores one or more documents in a user mailbox;*

*transmit information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer;*

*receive synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing;*

*update the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer;*

*display the updated list of user mailbox documents to a user on a display of the information appliance;*

receive a selection of one or more documents from the displayed list of user mailbox documents;

receive a command to print the one or more selected documents; and

transmit a print request to a nearby printer in response to receiving the command to print that instructs the printer to retrieve the

one or more selected documents from the user mailbox and print the one or more selected documents.

Regarding claim 15, Wolff does not teach or suggest a remote computer that “stores one or more documents in a user mailbox” as is described above. Furthermore, Wolff does not teach or suggest computer instructions that cause an information appliance to “transmit information regarding a list of documents stored on the information appliance from the information appliance to the remote computer”, “receive synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing”, or “update the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer”, for reasons described in the foregoing.

Moreover, Wolff does not teach or suggest computer instructions that cause an information appliance to “display the updated list of user mailbox documents to a user on a display of the information appliance” given that no “list” is provided to Wolff’s PDA.

For the above reasons, Applicant respectfully submits that claim 15 and its dependents are allowable over Wolff.

With specific regard to claim 17, Wolff does not teach a print request that “comprises identification information for the remote computer”.

### **B. Rejection of Claims 3 and 22**

Claims 3 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolff as applied to claims 1, 2, 15, and 21, and in view of Dalton (U.S. Pat. No. 6,246,211). Applicant respectfully traverses this rejection.

As is identified above, Wolff does not teach various limitations of claims 1 and 15. In that Dalton does not remedy the deficiencies of the Wolff reference, Applicant respectfully submits that claims 3 and 22, which depend from claims 1 and 15, respectively, are allowable over the Wolff/Dalton combination for at least the same reasons that claims 1 and 15 are allowable over Wolff.

### **C. Rejection of Claims 5 and 8**

Claims 5 and 8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolff as applied to claim 1, and in view of Eldridge, et al. (“Eldridge,” U.S. Pat. No. 6,430,601). Applicant respectfully traverses this rejection.

As is identified above, Wolff does not teach various limitations of claim 1. In that Eldridge does not remedy the deficiencies of the Wolff reference, Applicant respectfully submits that claims 5 and 8 which depend from claim 1, are allowable over the Wolff/Dalton combination for at least the same reasons that claim 1 is allowable over Wolff.

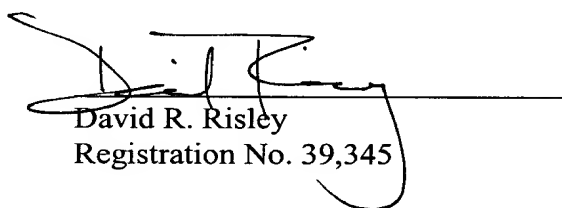
## **II. Canceled Claims**

Claims 4, 11-14, and 18-20 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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